

# DO NOT ENTER

## Remarks

The above Amendments and these Remarks are in reply to the Final Office Action mailed May 10, 2007. No fee is due with this REPLY.

### A. Withdrawal of Claims 8-17

The Examiner withdrew claims 8-17 as directed to inventions considered to be independent or distinct from the invention originally claimed. Claim 8 has been amended to depend from claim 1 and claim 13 has been amended to depend from claim 3. Claims 9-12 now depend ultimately from claim 1 and claims 14-17 now depend ultimately from claim 3. Thus, all claims presented are drawn to the same invention. Applicants respectfully request that claims 8-17 be rejoined into the application.

### B. Rejections under 35 U.S.C. §112, second paragraph

Claims 1-6 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claims 1, 3, and 5 stand rejected under 35 U.S.C. §112, second paragraph due to the recitation "to produce a prognosis of an outcome of a disease or its treatment" (emphasis added). The Examiner asserted:

Due to the use of passive language, it is unclear if this limitation is intended to be an active method step (i.e. producing a prognosis), an intended use or otherwise. Correction is requested via clearer claim language. (Final Office Action, p. 4, 4<sup>th</sup> para.)

Claims 1, 3, and 5 have been amended to recite "to predict an outcome of a disease or its treatment" (emphasis added). Claims 1, 3, and 5 therefore are now definite. Thus Applicants believe that the amendment overcomes the Examiner's rejection. Further, Applicants respectfully submit that the amendments do not add any limitations not already present in the claims, and therefore, no new search is required.

Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. §112, second paragraph be withdrawn.

### C. Rejections under 35 U.S.C. §102

Claims 1-6 stand rejected under 35 U.S.C. §102(b) as anticipated by Barry et al. (U.S. Patent No. 6,081,786; hereafter, "Barry"). Claims 1-6 stand rejected under 35 U.S.C. §102(b) as anticipated by Slonim et al.